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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/803,319

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Daniel G. Anderson

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(MIT-9128)

5731

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EXAMINER

BAKER, MAURIE GARCIA

ART UNIT

PAPER NUMBER

1627

DATE MAILED: 07/01/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/803,319

Applicant(s)

Anderson et al

Examiner

Maurie Garcia Baker, Ph. D.

Art Unit

1627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ONE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-54 are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

DETAILED ACTION

Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1627 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Jyothsna Venkat, Supervisory Patent Examiner, at (703) 308-2439. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-20, drawn to a microarray of polymeric biomaterials, classified variously depending on the structure of the polymeric biomaterials, for example, class 530 subclasses 300+.
 - II. Claims 21-44 and 51-54, drawn to a method for high throughput screening, classified variously, for example, class 435, subclasses 29 – 40.52.
 - III. Claims 45-50, drawn to a method of preparing a microarray of polymeric biomaterials, classified variously, for example, class 435, DIG 49.
2. The inventions are distinct, each from the other, because of the following reasons:
3. Groups I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the array of Group I could be used in

the synthesis of further arrays of polymeric biomaterials (i.e. as a starting material for further chemical manipulations).

4. Groups I and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the array of Group I could be made by a different process than that of Group III. For example, the array could be made by synthesizing the polymeric biomaterials directly on the support instead of delivering the polymeric biomaterials as ready-made solutions.

5. Groups II and III are different methods. The methods are different because they use different steps, require different reagents and will produce different products and/or results. They therefore have different issues regarding patentability and enablement and represent patentably distinct subject matter. The method of Group II is a method of **screening** an array and the method of Group III is a method of **making** an array. These have completely different steps and different end results.

6. These inventions have acquired a separate status in the art as shown by their different classification and/or divergent subject matter and would require different searches. The different inventions listed would require completely different searches in

both the patent and non-patent databases, and there is no expectation that the searches would be coextensive. Therefore an undue search burden exists and restriction for examination purposes as indicated is proper.

7. This application contains claims directed to patentably distinct species of the claimed invention for **Groups I – III**. Election is required as follows.

8. If applicant elects the invention of **Group I**, applicant is required to elect from the following patentably distinct species. Please elect one species from *each* subgroup (A – E) below. Claims 2 and 15-20 are generic.

A. Species of bond between element and surface

(1) Non-covalent***

(2) Covalent

***If non-covalent is elected, please elect a *specific type* of non-covalent interaction from those set forth in claim 8.

B. Species of base material

(1) Glass

(2) Plastic

(3) Metal

(4) Ceramic

(5) Combinations (elect a specific combination)

C. Species of hydrogel

One *specific type* of hydrogel should be elected, for purposes of search from those set forth in claims 5, 6 and 7.

D. Species of array

(1) Polymeric biomaterial elements further comprise a compound (claims 12-14)

(2) Polymeric biomaterial elements **do not** further comprise a compound

E. Species of polymeric biomaterial

Finally, the *specific* type of polymeric biomaterial elements should be elected, for purposes of search from those set forth in claims 10-14. Note that if polymeric biomaterial elements that further comprise compounds are elected (D(1) above), then the following elections should also be made:

Type of compound: Elect from those set forth in claim 12

Type of interaction: (a) covalent, claim 13; (b) non-covalent, claim 14

The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made. Therefore, the species have different issues regarding patentability and represent patentably distinct subject matter.

9. If applicant elects the invention of **Group II**, applicant is required to elect from the following patentably distinct species. Please elect one species from *each* subgroup (A – E) below. Claims 21 and 34 are generic.

A. Species of bond between element and surface

(1) Non-covalent***

(2) Covalent

***If non-covalent is elected, please elect a *specific type* of non-covalent interaction from those set forth in claim 27.

B. Species of hydrogel

One *specific type* of hydrogel should be elected, for purposes of search from those set forth in claims 23, 24 and 25.

C. Species of array

(1) Polymeric biomaterial elements further comprise a compound (claims 31-33 and 51-54)

(2) Polymeric biomaterial elements **do not** further comprise a compound

D. Species of polymeric biomaterial

The *specific type* of polymeric biomaterial elements should be elected, for purposes of search from those set forth in claims 29-33. Note that if polymeric biomaterial elements that further comprise compounds are elected (C(1) above), then the following elections should also be made:

Type of compound: Elect from those set forth in claim 31 and/or 52-54

Type of interaction: (a) covalent, claim 32; (b) non-covalent, claim 33

E. Species of assay

- (1) Cellular proliferation, claim 42
- (2) Cellular differentiation, claim 43
- (3) Gene expression, claim 44

The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made. For the different species of assay, they would require different steps and different reagents and will have different products and/or results. Therefore, the species have different issues regarding patentability and represent patentably distinct subject matter.

10. If applicant elects the invention of **Group III**, applicant is required to elect from the following patentably distinct species. Claims 45, 49 and 50 are generic.

Species of liquid handling device

- (1) Deposits via pin fluid deposition
- (2) Deposits via syringe pumped fluid deposition
- (3) Deposits via piezoelectric fluid deposition

The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in the parts from which they are made. Therefore, the species have different issues regarding patentability and represent patentably distinct subject matter.

11. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

12. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is

allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

13. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

14. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

15. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Because the above restriction/election requirement is complex, a telephone call to applicants to request an oral election was not made. See MPEP § 812.01.

16. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

17. Applicant is also reminded that a 1 - month (not less than 30 days) shortened statutory period will be set for response when a written requirement is made without an action on the merits. This period may be extended under the provisions of 37 CFR 1.136(a). Such action will not be an "action on the merits" for purposes of the second action final program, see MPEP 809.02(a).

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie Garcia Baker, Ph.D. whose telephone number is (703) 308-0065. The examiner can normally be reached on Monday-Thursday from 9:30 to 7:00 and alternate Fridays.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat, can be reached on (703) 308-2439. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding

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should be directed to the receptionist whose telephone number is (703) 308-0196.

Maurie Garcia Baker, Ph.D.
June 25, 2002


MAURIE E. GARCIA, PH.D
PATENT EXAMINER



RESTRICTION ELECTION FACSIMILE TRANSMISSION

DATE:

FROM/ATTORNEY:

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PAGES, INCLUDING COVERSHEET:

PHONE NUMBER:

TO EXAMINER: Maurie Garcia Baker, Ph.D.

ART UNIT: 1627

SERIAL NUMBER:

FAX/TELECOPIER NUMBER: (703) 308-4315

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